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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MINORU TAKEBE

Serial No.: 10/070,889

Filed: March 6, 2002

For: ANTI-OBESITY MATERIAL

Art Unit: 1617

Examiner: Jennifer M. Kim

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop: Appeal Brief – Patents

Dear Sir:

This is an appeal from the final rejection of the Examiner in Art Unit 1617 dated January 31, 2005, rejecting the Claims 1-7 of the application identified here and above.

REAL PARTY IN INTEREST:

The party named in the caption of the Brief is the inventor and the inventor has assigned his right, title and interest to Nichimo Co., Ltd., 2-20, Higashishinagawa 2-chome Shinagawa-ku, Tokyo 140-0002, Japan. Such assignment was recorded at the United States Patent and Trademark Office at reel 12879, frame 945 on March 6, 2002.

RELATED APPEALS AND INTERFERENCES: None

STATUS OF THE CLAIMS:

A. Rejection of the Specification and Claims on Non-Reference Grounds:

1. None.

B. Rejection of the Claims on Reference Grounds:

1. The Claims 1-7 are rejected under 35 U.S.C. 102 as being anticipated by the cited art. In support of the Examiner's position, the Examiner states:

"Claims 1-7 are rejected under 35 U.S.C. 102 as being anticipated by Takebe et al. (US Patent No. 5,885,632)."

C. Claims Under Appeal:

1. Claims 1-7 are the subject of this Appeal.

STATUS OF THE AMENDMENTS:

Appellant has filed no amendment in response to the Final Office Action and has instead filed a Notice of Appeal. The claims are as they appear in the attached Appendix.

SUMMARY OF THE CLAIMED SUBJECT MATTER:

The present invention relates to anti-obesity material capable of controlling weight increase while controlling food consumption and enhancing in vivo immune function as a result of being absorbed in vivo (see Technical Field, page 1, lines 4-7). The anti-obesity material contains isoflavone aglycone which is absorbed in vivo to control food consumption while enhancing immune function (see page 5, lines 1-3). The isoflavone aglycone are preferably materials derived from grains such as pulse crops and the isoflavone aglycone is preferably produced by way of fermentation of pulse crops by koji mold and hydrolysis of the components of the pulse crops after fermentation with the koji mold (see page 5, lines 4-7). The isoflavone aglycone obtained by the fermentation of the pulse crops by the koji mold and hydrolysis is extracted and concentrated utilizing a solvent and is preferably brought to a daizein content of at least 70 wt% (see page 5, lines 8-10) and the isoflavone aglycone is provided in high quantities sufficient to have the anti-obesity effect (see page 10, Table 2). The anti-obesity material is made into an oral supplement so it can be easily taken orally and safely absorbed in the digestive tract (see page 5, lines 11-12).

REFERENCES CITED:

- A. Takebe et al., US Patent No. 5,885,632.

Appellant has carefully reviewed Takebe et al., and respectfully submits that it discloses a method for preparing a food product from a pulse crop which is fermented utilizing a koji mold. The food product has anti-cancer properties and further is used as a feed for livestock and as an aquacultural feed, and Appellant respectfully submits that it teaches nothing concerning anti-obesity. Still further, the food product contains aglycones, and particularly contains daizein and genstein, but may contain other aglycones such as daizein and glycerin. Appellant respectfully submits that these aglycones are possessed in very small quantities and particularly from Tables 2 and 3 in columns 7 and 8, the amount is approximately 133 mg per 200 g and 194 mg. per 200 g respectively. Appellant respectfully submits that this reference does not teach concentrating the aglycones, and particularly does not teach concentrating the daizein by means of a solvent. Still further, the Examiner appears to rely on Table 3 for his statement that the preparation comprises at least 70 wt% daizein. Appellant respectfully submits that the total amount of aglycones appears to be 194 mg in 200 g, and of this 100 mg is daizein. Accordingly, Appellant respectfully submits that the weight percentage of daizein is approximately 52% and not 70%.

In addition to the above, Appellant would like to point out that the patent to Takebe et al. is commonly owned with the owner of the present application, and at least one inventor between the present application and Takebe et al. is uncommon, but the entire inventive entity is different.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

The Claims 1-7 were rejected by the Examiner as being anticipated by Takebe et al., and it is Appellant's position that Takebe et al. not only does not show Appellant's invention, but also does not show each and every element of Appellant's invention.

ARGUMENT:

As is discussed above, Appellant respectfully submits that Takebe et al. is directed towards a process for preparing a food product with anti-cancer properties and also which could be used for a feed for livestock and aquaculture. In contrast thereto, Appellant's invention is entirely directed towards an anti-obesity material, something not anticipated by Takebe et al.

since Takebe et al. does not recognize this property. Still further, Appellant respectfully submits that the preamble of Appellant's claims is a limitation and should not be given no patentable weight since it provides an environment for Appellant's invention in the same manner as in the case of Sumitomo v. Corning Glass which was decided by the Court of Appeals for the Federal Circuit. Still further, Appellant respectfully submits that the quantities of isoflavone aglycone produced in Takebe et al. are too small to have any anti-obesity effect. Particularly, Appellant directs the Board's attention to Table 3 wherein it indicates that only 190 mg per 200 g of isoflavone aglycones are produced; in contrast thereto, in Appellant's invention as is shown in Table 2 on page 10, 1,050 isoflavone aglycones per 100 gm are generated. Accordingly, Appellant respectfully submits that Takebe et al. does not disclose the anti-obesity material as claimed by Appellant's invention in Claims 1-7.

In addition, Appellant respectfully submits that Takebe et al. does not show or suggest concentration of the material to produce more isoflavone aglycone in the final product as is claimed by Appellant's Claim 5. Also, Appellant respectfully submits that Takebe et al. does not disclose that the isoflavone aglycones contain at least 70 weight percent daizein, and instead in Table 3, relied upon by the Examiner, appears to show at best 52%.

In view of the above, therefore, Appellant respectfully submits that not only is the product of Takebe et al. not Appellant's invention, but also Takebe et al. does not teach each and every element of Appellant's invention as claimed. Therefore, Appellant respectfully submits that the Claims 1-7 are not anticipated by Takebe et al.

CONCLUSION:

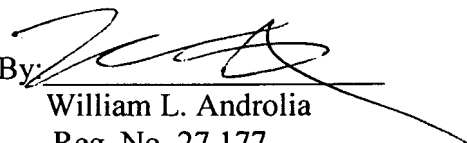
The finally rejected Claims 1-7 of Appellant's application are respectfully submitted as clearly allowable for the reasons summarized as follows:

1. The Claims 1-7 are not anticipated by the prior art.
2. Allowance of the Claims 1-7 are earnestly solicited.
3. Also, please charge the fee for filing this Appeal Brief in the amount of \$500.00 to KODA & ANDROLIA DEPOSIT ACCOUNT NO. 11-1445 and this Appeal Brief is submitted in triplicate.

Please charge any costs incurred by or in order to implement this Appeal Brief or any other additional fees required for any extensions of time in order to enter this Appeal Brief to KODA & ANDROLIA DEPOSIT ACCOUNT NO. 11-1445.

Respectfully submitted,

KODA & ANDROLIA

By: 
William L. Androlia
Reg. No. 27,177

2029 Century Park East
Suite 1140
Los Angeles, CA 90067-2983
Tel: (310) 277-1391
Fax: (310) 277-4118

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Name

Signature

1/24/2006
Date

CLAIMS APPENDIX

Claim 1 (previously presented): An anti-obesity material, characterized in that said anti-obesity material contains isoflavone aglycone.

Claim 2 (previously presented): The anti-obesity material according to claim 1, characterized in that said isoflavone aglycone is a material derived from grains.

Claim 3 (original): The anti-obesity material according to claim 2, characterized in that said grain-derived material is produced by performing fermentation of grains by koji mold so as to decompose protein and then by performing hydrolysis.

Claim 4 (original): The anti-obesity material according to claim 3, characterized in that said grains are pulse crops.

Claim 5 (original): The anti-obesity material according to claim 3 or 4, characterized in that said isoflavone aglycone is produced by further performing concentration of a material produced by hydrolysis.

Claim 6 (original): The anti-obesity material according to claim 5, characterized in that said isoflavone aglycone contains at least 70 wt% daizein.

Claim 7 (original): The anti-obesity material according to any one of claims 1 through 6, characterized in that said anti-obesity material is formed into an oral supplement.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.